

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Regarding: Leslie E. Smith et al.
Serial No. 10/743,936
Filing Date 12/23/2003
For FORMATION OF WIDE PAINT FILM PARTS

Renewed Petition to Instruct Examiners
to Withdraw Restriction, and Complaint

Attention: Group Art Unit 1732
SUPERVISOR OF Examiner Monica A. Fontaine,
and SPE Michael P. Colaianni

M.S. AF
Commissioner for Patents
Alexandria, VA 22313-1450

In consideration of the 04/18/2005 final Office action and the 07/07/2005 Advisory Action, closed 7-9 in its envelope for its mailing, for the present utility patent application, please promptly instruct the Examiners to withdraw the restriction of present claims 32-25 and examine these claims. Reconsideration was requested in the Amendment filed on January 26, 2005; no fee is due herefor; and traverse is maintained of the restriction.

In complaint, the Examiners, by the Advisory Action, treated the Petition to Instruct Examiners to Withdraw Restriction filed on June 17, 2005 concurrently with the AF Remarks as if it were a request for reconsideration not for, and so avoided, supervisory review, delaying action on the issue. That occurred even though the petition manifestly was directed to the SUPERVISOR OF the Examiners, and noted the prior request for reconsideration.

The present petition is for the SUPERVISOR OF the Examiners.

Reconsideration of the restriction has been amply requested.

Notice of appeal is submitted herewith.

The following was submitted in the Petition to Instruct Examiners to Withdraw Restriction, and is maintained hereby:

As noted on the introductory page of the Amendment, claims 32-35 are product-by-process claims, each requiring manufacture by a method as of elected claim 10. See, the Amendment, or the Appendix of the AF Remarks filed concurrently herewith. (These claims replaced and augmented restricted, canceled product claims 16-19.) Such a claimed product by process, by definition, cannot be made by another materially different method such as extrusion.

The product is made from laminated paint film sheet stock, and is wider than the starting stock. No prior art shows this.

The Examiners had been requested by the Amendment to provide a reference that would support their assertion, but failed to do so. Clearly, the claimed product is not known nor cannot be made

by extrusion as baldly asserted by the Examiners.

There is no undue search burden. A search for the elected method is in effect a search for the product made by that method.

In addition, the following is submitted:

Although the product claimed by claims 32-35 is an article, unlike that which recently was improperly made of record in the Advisory Action, page 2, first paragraph, it is not limited only by structural limitations, and the invention at issue as claimed is not to be examined solely on the basis of article structure. It is well settled law that every claim limitation is to be considered. Citations omitted.

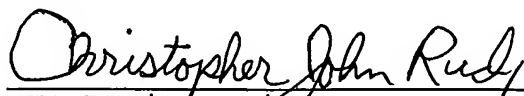
According even to MPEP 806.05(f) (August 2001), a process of making and a product made by the process can be restricted only if (A) the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; or (B) the product as claimed can be made by another and materially different process. The Examiners brought their restriction under part (B) only, saying, again, that the product could be made by extrusion.

The claims, once again, do not recite extrusion; thus, by definition, such a claimed product by process cannot be made by another materially different method such as extrusion. As noted in the original petition, the product is made from laminated paint film sheet stock, and is wider than the starting stock; no prior art shows this. Moreover, again, the Examiners had been requested by the Amendment to provide a reference in support of their assertion, but failed to do so. The claimed product is not known nor cannot be made by extrusion as baldly asserted by these Examiners. In other words, the wide paint film products required in the claims at issue are novel, unknown to any art, to include the art of extrusion. If a reference cannot be found to support their speculative assertion, the Examiners are hereby invited through their supervisor who is considering the present petition to supply other factual knowledge that would support their speculative assertion by means of an Examiners' affidavit. The Applicant has convincingly traversed the requirement. It is up to the Examiners to document their assertion as viable, or else the restriction must be withdrawn.

Please, therefore, instruct the Examiners to withdraw the restriction requirement of claims 32-35 and examine these claims.

Respectfully,

Dated: July 13, 2005 A.D.


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